

REMARKS

Claims 1-9 and 11-27 are pending in this application; claims 1, 6, 16-19, 26, and 27 being independent. In light of the amendments and remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

The Official Action

In the outstanding Official Action, the Examiner rejected claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over *Garfinkle et al.* (USP 6,133,985) in view of *Parulski* (EP 0 860 980 A2).

Claim Rejections - 35 U.S.C. § 103

With regard to the Examiner's rejection of claims 1-15 under 35 U.S.C. § 103(a), Applicants respectfully traverse these rejections.

In order to sustain a claim rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet her burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, the Examiner must comply with the standard of patentability applied in obviousness rejections. Specifically, the Examiner must determine the scope and content of the prior art; ascertain the differences between the prior art and the claims in

issue; resolve the level of ordinary skill in the pertinent art; and evaluate evidence of secondary considerations. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

With regard to claims 1 and 6, it is respectfully submitted that the Examiner has failed to point out in the outstanding Official Action the deficiencies of the teachings of *Garfinkle et al.* Additionally, the Examiner has failed to provide Applicants with those portions of the *Parulski* reference the Examiner is relying upon in establishing her 35 U.S.C. § 103(a) rejection. As such, the requirements of *Graham v. John Deere* have not been satisfied and Applicants respectfully request that the rejections be withdrawn. If the Examiner maintains the outstanding rejections, Applicants request that the Examiner provide a complete explanation of those portions of both references the Examiner is relying upon in support of her rejections and, further, what the deficiencies of the teachings of the primary reference are and what motivation the Examiner has to combine the references. This will enable Applicants to properly consider whether any additional claim amendments are warranted.

By this Amendment, Applicants have added new claims 16-27. It is respectfully submitted that new independent claims 16 and 17 are allowable over the art cited by the Examiner, as *Garfinkle et al.*, *Parulski* or a combination thereof, assuming these references are combinable, which Applicants do not admit, fail to teach generating an electronic mail message wherein the mail address of the application server is set as an address of the sender.

With regard to new independent claims 18 and 26, it is respectfully submitted that *Garfinkle et al.*, *Parulski*, or a combination thereof, fail to teach a method of sending

electronic mail messages with attached images in a network photograph service system comprising displaying the selected at least one image in a manner that distinguishes the at least one image from the rest. As such, it is respectfully submitted that claims 18 and 26, and their respective dependent claims, are allowable over the cited art.

With regard to new independent claims 19 and 27, it is respectfully submitted that *Garfinkle et al.*, *Parulski*, or a combination thereof, fail to teach a method of sending electronic mail messages with attached images in a network photograph service system comprising displaying at the same time a comment box, a destination input box, and images having been selected as targets of transmission. As such, it is respectfully submitted that independent claims 19 and 27, and their respective dependent claims, are allowable over the art as cited by the Examiner.

CONCLUSION

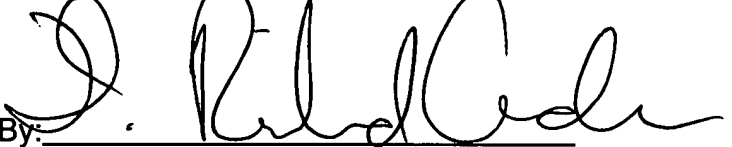
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Provisional Reg. No. P-52,327) at the telephone number below to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition for a three (3) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$920.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version With Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 10 has been cancelled without prejudice or disclaimer of the subject matter contained therein.

The claims have been amended as follows:

1. (Twice Amended) [A] An application server used in a network photograph service system comprising:

image storing means for storing a plurality of images;

image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be viewed on the network;

mail generating means for generating an electronic mail message with the selected image as an attachment to the electronic mail message, without requiring a recipient of the electronic mail with attached image to activate an address that points the recipient to a file which stores the selected image;

destination address specifying means for enabling the service user to specify a destination address of the electronic mail message; and

mail transmitting means for transmitting the electronic mail message to the destination address specified by the destination address specifying means.

2. (Twice Amended) [A] An application server used in a network photograph service system as claimed in claim 1, further comprising comment inputting means for enabling the service user to input a comment on the image selected by the image selecting means,
wherein the mail generating means generates an electronic mail message including the input comment as text.

3. (Three Times Amended) [A] An application server used in a network photograph service system as claimed in claim 1, further comprising attachment mode selecting means for enabling the service user to select an attachment mode by presenting a plurality of attachment modes as formats for attaching the image,
wherein the mail generating means attaches the image according to the attachment mode selected by the attachment mode selecting means.

4. (Twice Amended) [A] An application server used in a network photograph service system as claimed in claim 1, wherein the destination address specifying means enables specification of a plurality of destination addresses for one electronic mail message.

5. (Twice Amended) [A] An application server used in a network photograph service system as claimed in claim 1, further comprising user address setting means for enabling the service user to set their electronic mail address thereof,

wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message.

6. (Twice Amended) [A] An application server used in a network photograph service system, comprising:

image storing means for storing a plurality of images;

image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be viewed on a network;

mail generating means for generating an electronic mail message with an address of the selected image;

destination address specifying means for enabling the service user to specify a destination address of the electronic mail message; [and]

mail transmitting means for transmitting the electronic mail message to the specified destination address; and

user address setting means for enabling the service user to set their mail address.

8. (Twice Amended) [A] An application server used in a network photograph service system as claimed in claim 6, wherein the destination address specifying means enables specification of a plurality of destination addresses for one electronic mail message.

9. (Twice Amended) [A] An application server used in a network photograph service system as claimed in claim 6,

wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message.

11. (Amended) The method of claim 18 [10], further comprising obtaining image identification information of the selected image and destination address information of desired recipient subsequent to said selecting step, said obtaining performed by the center server.

12. (Amended) The method of claim 18 [10], wherein the recipient receives the electronic mail message with attached image without having to activate an address in the text of the message that points the recipient to a file on the center server that stores the selected image.

13. (Amended) The method of claim 18 [10], further comprising inputting comment data on the selected image, said inputting performed by the user of the system before said electronic mail message with attached image is transmitted to the recipient.

14. (Amended) The method of claim 18 [10], further comprising selecting a desired attachment mode from a plurality of selectable attachment modes as formats for attaching the image to the electronic mail message, said selecting performed by the user of the system.

15. (Amended) The method of claim 18 [10], further comprising setting the user's send address for sending the electronic mail message with image attachment, said setting performed by the user, wherein said transmitting step transmits the electronic mail message with image attachment using the set send address of the user.

New claims 16-27 have been added.